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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DIXON, THOMAS A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 05/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/498,369

Applicant(s)

SHEAR ET AL.

Examiner

Thomas A. Dixon

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 136-185 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 151-154 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1, 136-150 and 156-185 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7, 8.                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of groups V and VI in Paper No. 4 is acknowledged.  
Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Further, examiner thanks applicant for pointing out that invention VI is a method and not a system claim as examiner had stated in item 5 of the election restriction requirement, upon reconsideration of the claims, it is seen that the claims of group IV are to usage monitoring, similar to group IV and would, in fact, be classified in class 705, subclass 52 and will not be examined.

### ***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application

Art Unit: 3629

being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 151- are rejected under 35 U.S.C. 102(e) as being anticipated by Erickson (5,765,152).

As per Claim 151.

Erickson ('152) discloses:

creating a secure container, see column 4, line 61 – column 5, line 4;  
associating a first rule with the secure container, the rule at least in part governing use of at least some of the secure container contents, the first rule at least in part specifying potential users or recipients of the secure container contents, the specification being based at least in part on a class to which the potential users or recipients have been assigned, see figure 7D;

sending the secure container to a first remote party, see figure 1, (10);

the first remote party embedding a content object in the secure container, see column 9, lines 7-23;

sending the secure container, including the embedded content object, to a second remote party, the second remote party consisting of a potential user, see figure 1 (10);

evaluating a digital certificate associated with the potential user, see column 24, lines 45-52;

determining, based at least in part on the digital certificate, that the potential user has been assigned to a class, see column 24, lines 47-52;

based on the determination, and at least in part under control of the first rule, making at least some of the secure container contents available to the potential user, see column 24, lines 53-56.

As per Claim 152.

Erickson ('152) discloses all the limitations of claim 151.

Erickson ('152) further discloses:

the first remote party associating a second rule with the secure container, the second rule at least in part governing use of at least a portion of the secure container contents, see column 22, line 30 – column 23, line 33, column 26, lines 18-31 and figure 5, (server issues auxiliary permissions for licensed use)

the step of making at least some of the secure container contents available to the potential user occurring at least in part under control of the second rule, see column 24, lines 39-57 and column 26, lines 18-31.

Art Unit: 3629

As per Claim 153.

Erickson ('152) discloses all the limitations of claim 151.

Erickson ('152) further discloses:

assigning the potential user to the class, the assignment being based at least in part on the potential user's use of the content, see figure 7D.

As per Claim 154.

Erickson ('152) discloses all the limitations of claim 153.

Erickson ('152) further discloses:

the class is based at least in part based on demographic information, see column 21, lines 41-49.

As per Claim 155.

Erickson ('152) discloses all the limitations of claim 154.

Erickson ('152) further discloses:

following the potential user's access to the secure contents, generating an audit trail to a remote site, see column 22, lines 36-47.

#### ***Prior Art Made of Record***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Prior art patents listed on page on page 1 of the 892 were considered in the original case 08/965,185, but were not presented in the IDS submitted.

EP 0 398 645 to Fabbio is the closest European reference and teaches releasing objects to authorized classes of users based on authorization rules, but does not disclose all the limitations of the claims.

Securing the Content, Not the Wire, for Information Commerce, by Sibert et al is the closest Non-Patent Literature and teaches the concept of enclosing copyrighted works in secure digital containers for distribution in an e-commerce system.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7238 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

A handwritten signature in black ink, appearing to read "Thomas A. Dixon".

Thomas A. Dixon  
Examiner  
Art Unit 3629

May 21, 2002